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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951

INGERSOLL-RAND COMPANY and ROBERT H. POTT, HOLSCLAW BROTHERS, INC. and CHARLES H. HOLSCLAW, Trustee,

Petitioners,

vs.

BLACK & DECKER MANUFACTURING COMPANY,

Respondent.

No.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, Ingersoll-Rand Company, Robert H. Pott, Holsclaw Brothers, Inc. and Charles H. Holsclaw, Trustee, pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fourth Circuit in the above entitled case.

A certified transcript of the record, including the proceedings in said Court of Appeals, is furnished herewith in compliance with Rule 38 of the rules of this Court.

Summary Statement of the Matter Involved

This is a suit for infringement of the Pott patent 2,012,916, granted August 27, 1935 upon application filed January 30, 1932 (PA 161).* The district court, in Baltimore, Maryland, decided that the patent was invalid, for want of patentable invention, and that it was not infringed, 94 F. Supp. 938 (PA 3, 23, 24). The Court of Appeals for the Fourth Circuit on November 5, 1951 affirmed on the same ground of invalidity, without deciding infringement, 4 Cir., 192 F. 2d 270 (R 255). A petition for rehearing as to validity was duly filed on December 5, 1951, but was denied December 27, 1951, *one judge dissenting* (R 268).

This Court is asked to take the cause to decide the question of patentable invention, under the standards announced and applied by this Court, and which we believe to have been misapplied by the courts below.

Jurisdiction

The jurisdiction of the Court is invoked under Section 240(a) of the Judicial Code as amended June 25, 1948, effective September 1, 1948 (28 U. S. C., Section 1254(1)) and under Section 5(b1) of Rule 38 of this Court.

The pertinent patent statute is 35 U. S. C. 31; R. S. 4886, set forth in an appendix hereto.

Question Presented and Specification of Errors

Does the Pott invention, being that of an individual, independent inventor, and producing a new result according

*PA is Appellants' Appendix.

to a new principle of operation, resulting in a tool admittedly "new" and "amazing", the use of which greatly improved conditions of labor, and against which the only prior art held to negative invention was three patents, no one of them disclosing Pott's novel principle of operation or new result, and none shown to have advanced or even contributed to this art, meet the standards of invention as now set by this Court?

The error into which the courts below fell, complained of here, is their failure to sustain as valid, against the defense of non-patentable invention, a patent which this Court would so sustain and which plainly meets the highest standards of invention set by this Court.

Reasons for the Allowance of the Writ

No other case involving this patent has been tried, and therefore there is no conflict of decisions concerning its validity or infringement.

Although the courts below concurred in their veiws concerning the validity of the Pott patent, that does not prevent this Court from correcting the decisions below, if erroneous, *Great A. & P. Tea Co.* v. *Supermarket,* 340 U. S. 147, and *Crest Specialty* v. *Trager,* 341 U. S. 912.

The grounds for certiorari are that the views of the courts below, that the patent did not embody "patentable invention" as established by the recent opinions of this Court, including the *Great A. & P. Tea* case, *supra,* were incorrect; that the plain intent of this Court's decision in the *Great A. & P. case* has been and is being misinterpreted and misapplied by lower courts and has caused much uncertainty and confusion concerning the extent, if any, to

which it changed the law as to what constitutes invention*; and that the importance, to the bench and bar, of this Court now making a clarifying application, for which the present is an appropriate case, of the principles which this Court has, for over a century, declared to be applicable to patents, far transcends the matters and parties here involved, because of the great *public interest* in having a clear understanding of the law of patents as it now stands. Particularly, recent decisions seem to have created confusion as to *all* patents, because almost every patent has claims which, upon analysis, may be taken as combinations of elements, be they all old or some old and some new. *The Great A. & P. Tea case* has been cited by lower courts as though "combination claims" were in some special class, offensive because of their form and, therefore, to be viewed with especial suspicion. Yet the form is, in fact, that which is most widely prevalent in patents and few, indeed, are the inventions susceptible of being adequately claimed in any other form.

The granting of patents to encourage the making and disclosing of inventions is the policy and practice of the United States. Thousands of patents each year are issued by the Government under its seal, with the unqualified statement on the patent that "upon due examination made the said claimant is adjudged to be justly entitled to a patent under the Law." There should be no doubt that this Court, the final interpreter of the federal statutes, will sustain combination patents when they have inventive merit, correcting erroneous decisions below when necessary or advisable.

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*E.g., *McCord Corporation* v. *Beacon Auto Radiator, Inc.*, 1 Cir., decided January 31, 1952, 92 U. S. P. Q. 163 at pp. 165-167 (not yet officially reported).

BRIEF

The controlling facts are undisputed. The question is one of law only, as the Pott patent was invalidated, despite its novelty, utility, great success and extensive use, because of three prior patents which are in the record and whose simple mechanical structures are easily understood. The differences between the parties are as to what are the proper legal inferences from the facts.

The Pott patent discloses and claims an "impact" tool for first running down and then tightening a nut on a bolt by combining two *different* and *successive* modes of operation, each under its appropriate condition—first, with the parts of the tool clutched together, in which condition all hammering and impact is absent and the nut is simply run down to its seat by *continuous* rotation; second, after the nut is seated and so offers resistance, the clutching ceases and one part of the tool hammers the other part with *intermittent* rotary impact to tighten the nut by a succession of *rotary* impact blows (claim 3; opinion of the Court of Appeals, R 257). Transition from the first to the second mode of operation is *automatic* and automatically occurs *at the proper time.*

Prior to Pott, so-called "torque" wrenches were used to twist nuts, bolts and the like, either to tighten or to loosen. Electric or air power was often employed, to hasten the process, but the man handling the wrench had to absorb in his own body all the torque (twisting force) required for the work. Thus, if the torque required was 100 foot pounds, the 100 foot pound resistance from the nut to the wrench had to be absorbed by the arms, body and legs of the man holding the wrench. This was particularly serious when the shock was sudden, as when the nut's resistance

suddenly changed from practically zero, during the preliminary free running down of the nut, to a maximum after the nut was seated. Not only was the fatigue great, so that "in the automotive industry it created *quite a labor turnover,* on account of the strain on the operator's hands" (Pott, PA 96), but when working on high bridges and scaffolding, the sudden shock was often dangerous.

Because of these troubles, many attempts were made, over a long period of years, to improve the old "torque" wrenches, including patents taken out by respondent and others. For example, the Levedahl patent 1,684,633, relied upon by respondent, says that the vibration of "torque" wrenches "is suddenly thrown against the body and arms of the operator holding the tool against the work, the operation of the tool becomes *exceedingly burdensome and tiring",* and "in these tools this force is so strong that it tends to turn the entire tool out of the grasp of the operator" (PA 198).

The Pott "impact wrench" operates upon an entirely new principle, different from that of the prior "torque" wrench, in that while it acts like a "torque" wrench during the preliminary easy running down of the nut by the usual twisting action, when the resistance to turning (torque) suddenly increases upon seating of the nut, this action automatically changes to a series of *very rapid hammer blows,* delivered in a rotary or tangential direction, each of small torque accumulated in a spring but redelivered with tremendous cumulative effect, to tighten the nut to its final position.

An operator subjected to a torque of 150 foot pounds in tightening a nut when using a "torque" wrench, will have to withstand only 6 to 10 foot pounds with an "impact" wrench.

An "impact" wrench one-third the size of a "torque" wrench will tighten a nut better, will reduce by 85% the fatigue of the operator and will be safer to operate (Reynolds, PA 46, 49-52, 71-72). These facts are not contradicted. There is no dispute that before Pott there was in use no tool which operated automatically to rotate a nut *by continuous twisting* and automatically to rotate the same nut *by hammering* when the resistance increases, with automatic *transition* from the first to the second mode of operation, *at the proper time*. The patents relied upon by the courts below to invalidate the Pott patent were not intended to do, and in fact could not do, what the Pott tool admittedly accomplishes.

Respondent since at least 1921 had been making and selling many varieties of "torque" wrenches, some of which were patented (PA 126). After the Pott "impact" wrench came on the market, respondent's salesmen called respondent's attention to it as "possibly an item we should add to our line" because, so respondent's research engineer admitted, "They were afraid of not increasing their sales and commissions" (Ramey, PA 129). Respondent then, in 1949, after more than a quarter of a century of making and selling "torque" wrenches, commenced to sell "impact" wrenches, advertising in March, 1949, its new product as an "*Amazing, New* ⅜"* Electric Impact Wrench", including the following typical "impact" operation advantages, viz.:

> "1. The POSITIVE, sure-fire way to remove frozen, rusty bolts or nuts—FAST!
>
> "2. Delivers 2000 blows per minute to hammer fasteners loose or drive them home—IN A FEW SECONDS! (Free running speed: 1600 r.p.m.)

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*Italics ours.

"3. Weighs only 8¼ lbs., yet has DRIVING CAPACITY of coventional nut runner weighing almost 30 lbs.!

"4. Operator fatigue reduced to an *amazing** minimum . . .

NO { jarring / twisting / fighting the Wrench!

"5. So well-balanced, operator can control wrench by holding it lightly, with one hand!" (plffs. ex. 14; PA 170).

Respondent's 1949 catalogue stated, correctly (PA 173):

> "The Black & Decker Electric Impact Wrench is *a completely new unit** for rapid tightening and removal of nuts, bolts and cap screws. In tightening operations, the wrench spins *a free-running fastener** to a seating position by high speed direct drive; immediately the clutch throws into operation a rapid, positive *hammering** action which tightens the fastener into thousands of quick, sharp blows per minute. Just a few seconds of this positive impacting is all that is needed for maximum tightness. And there is *practically no torque reaction to the operator**—no uncomfortable jarring or twisting—no fighting the Wrench to get results."**

There is no dispute concerning the great value to industry of the "impact" wrench, the Court of Appeals saying "Of the *practical utility** of such a tool, there can be

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*Italics ours.

**This is an excellent description of the Pott "impact" wrench, which first spins the nut and then automatically hammers, unlike the prior "torque" wrenches and the Scanlon, Nielsen and Weibull prior art patents relied upon by respondent.

*no question**" (R 258). Nor is there any dispute that Pott was the first to make, sell and patent this tool.

Pott is a perfect example of the *individual, independent* inventor for whose protection the patent laws are indisputably intended. He was an independent mechanic out of a job during the depression year of 1930 and living in Evansville, Indiana, when he invented the "impact wrench", and with the aid of the Holsclaws, who had a small shop in Evansville, sold several of his wrenches to automobile manufacturers, where it was successfully used (Pott, PA 102). In 1934 Pott and the Holsclaws made a patent license contract with Ingersoll-Rand, under which it manufactured "impact wrenches", paying Pott and the Holsclaws up to the time of trial about three million dollars in royalties. As above stated, respondent in 1949 added what it then said was the "amazing" and "new" "impact" wrench to its old line of products, and this suit was promptly brought.

The Pott Patent Has Patentable Invention by the Highest Standards of this Court.

The question of invention in the Pott patent depends upon the inferences to be drawn from the prior patents to Scanlon 1,671,489 (PA 236), Nielsen 1,770,656 (PA 231) and Weibull 1,776,057 (PA 241), which the courts below decided negatived "patentable invention" in Pott. Although the tools of those patents were different from Pott's, and could not without complete change do what Pott's tool does, it seemed to the courts below that, despite Pott's contribution to the public of a novel and admittedly highly useful tool, he was not an "inventor" by the standards declared by this Court. Here, we think, was obvious error.

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*Italics ours.

The case for invention in the Pott patent is far stronger than that for the McFeely patent sustained by this Court in *Williams Co.* v. *Shoe Mach. Co.*, 316 U. S. 364, and also meets the tests specified in the dissenting opinion, per Mr. Justice Black. The McFeely patent was for a shoe machine invented by an employee of the United Shoe Machinery Company to improve an earlier shoe machine, by enabling it to work on shoes of different sizes. In that case the inventor was an employee of, and had the facilities of, a large company, there was no new result performed by the machine, which clamped the heel, positioned it, wiped and lasted as in prior machines, and the dissenting opinion declared (p. 384) that "the improvements here were but duplications of old elements to obtain an old result . . ." But in the present case, Pott, *an independent inventor*, did *not* merely "obtain an old result" by the mechanisms of his wrench, because it, for the first time, performed a *new* twisting-hammering operation on nuts and bolts, with greatly reduced fatigue and danger to the workman. His wrench was *not* the usual small and expected technological advance in the mechanical arts, because power wrenches had been known and used for at least a quarter of a century before Pott, and their defects had long been recognized. Pott did not merely improve the old power wrench; he created a *new tool*, operating on *a new and different principle*,—the "impact" wrench. He made an invention by the standards of the *Williams* case opinions.

And the patent in the *Great A. & P. Tea* case was very different from, and much weaker than, the Pott patent. There, the patent was for the combination of an old cashier's counter and its extension with an old three sided frame, each made and used exactly as before, the alleged inventive idea being merely to put together the two old things, without

any change in either the elements or their result. This Court held (p. 152) the patent bad, saying:

> "The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable".

Pott made a new tool, operating differently from any prior device. His tool *does* do more than "the sum of its parts", and mere addition of things from prior patents would *not* make a Pott tool. To make an "impact" wrench from Scanlon, Nielsen or Weibull would require not merely radical, but complete, changes in both the purposes and the structures of those patents, and in their modes of operation.

Scanlon is for use in drilling an oil well. He proposes to apply a sharp jar to a section of frozen pipe, by twisting a long drill pipe, untwisting to cause a jar, lifting the drill pipe to again twist it, and so forth in a step by step process. There is, and could be, no continuous rotation before jarring and no continuing series of jars. There is not a single mechanical part in Scanlon which could be used in Pott, even with modifications for Pott purposes.

Nielsen has a hammer with an elastic shaft, which rotates to drive downward a drill, by repeated impacts, like a man using a sledge hammer to drive a stake into the ground. There is no twisting (torque) of any kind.

Weibull, found by the court below to be the closest prior art (opinion of the Court of Appeals, R 259), *always* has impacting action under *all* operating conditions. Judge Chesnut in the district court found that Weibull has "axially directed *impact* force" and "rotary *impact* force" (Finding 16, PA 33) and always possesses these two *impact* components (k_a and k_t), in varying amounts (*ibid.*). Whether

Weibull is used for axial hammering action (utilizing component k_a) or for rotary hammering action (utilizing component k_t), Weibull *always* has these "impulses" or series of impacts, as he himself describes (PA 246). Dr. Hoppmann, for respondent, commenced his description of Weibull by admitting: "I think we might say at the outset that *the Weibull tool is strictly an impacting tool*" (DA* 144, our emphasis).

The holding of invalidity by the court below was on the ground that the claims "are invalid for *lack of invention* in the light of the prior art" (opinion of the Court of Appeals, R 257). A holding of lack of invention necessarily concedes, as Judge Chesnut seems also to have done, that Pott is not *anticipated* by Weibull,—hence that Pott *does* have *something* more than Weibull discloses. We most respectfully and with all deference urge that that "something" is a *new principle* of operation. This comprises two *different* and *successive* modes of operation under the respective *different* conditions appropriate to each, and with *automatic* transition from one mode to the other, *at the proper time.* These two modes are, first, a *continuous,* non-hammering operation for rundown and, thereafter, second, an *intermittent* rotary impact hammering operation for tightening against resistance, the transition from the former to the latter being accomplished *automatically* when the nut meets resistance. *Weibull's* teaching is directly contrary to this mode of operation (Weibull U. S. pat., 1,776,057, p. 3, ll. 110, 114; PA 243). Neither the initial *continuous* mode of operation nor, a *fortiori,* the automatic transition to the second mode, is taught by Weibull.

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*DA is Appellee's Appendix.

None of these prior patents was for a tool which would continuously rotate and automatically shift to hammering, and none could do so without radical changes amounting to invention.

After Pott devised his highly useful tool, which, being mechanical, necessarily must operate in accordance with mechanical laws, it is, of course, possible to find in prior patents examples of the use of isolated parts of the same laws, in different forms and for different purposes. But to combine those principles, in different forms and in a new way, to accomplish a new and beneficial result, never attained before, by creating a tool of great merit and undoubted utility, characterized even by respondent as "new" and "amazing", and as benefitting labor, is the very essence of "patentable invention" of the precise kind which the patent laws are intended to protect, meeting the *highest* standards set by this Court.

The Pott patent was infringed.

The trial court decided that respondent's "impact" wrench did not infringe the Pott patent (PA 24), the Court of Appeals not passing on this question (R 263). This Court, if certiorari be granted, may wish to remand the cause to the Court of Appeals for decision on infringement.

Respondent's accused device is admittedly an "impact" wrench, operating to continuously rotate until the resistance to turning increases, and then automatically hammering. As might be expected, respondent's 1949 wrench differs in some respects from the 1930 Pott wrench, as do 1949 automobiles, engine driven planes etc. from their 1930 models. The principal difference is that Pott has one set of teeth, which both rotate the nut, and then hammer, while respondent's wrench has two sets of teeth, each performing a dif-

ferent one of the two functions performed by the Pott single set. There are other differences, perhaps "to introduce minor variations to conceal and shelter the piracy", *Graver* v. *Linde,* 339 U. S. 605, 607, but nothing which affects its operation as an "impact" wrench. And although respondent has patented its own wrench, "It is well established that an improver can not appropriate the basic patent of another and that the the improver without a license is an infringer and may be sued as such", *Temco* v. *Apco,* 275 U. S. 319, 328.

Conclusion

The courts below were in plain error in deciding that there was no "patentable invention", as defined by this Court, and in holding invalid a patent which this Court would sustain according to its announced standards. Because of the public interest in clarifying the status of "combination" patents, the petition for writ of certiorari should be granted.

Respectfully submitted,

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February, 1952.

APPENDIX

35 U. S. C. 31; R. S. 4886. *Inventions patentable.*

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or *any new and useful improvements thereof,* * * * not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (R. S. sec. 4886; Mar. 3, 1897, ch. 391, sec. 1, 29 Stat. 692; May 23, 1930, ch. 312, sec. 1, 46 Stat. 376; Aug. 5, 1939, ch. 450, sec. 1, 53 Stat. 1212). (Emphasis supplied).